

C. REMARKS***Telephone Interview***

Applicants contacted Examiner Tieu on November 4, 2005 and requested to discuss a potential amendment with the Examiner in which Applicants proposed adding new dependent claims 60 and 61, dependent upon claim 37, which mirror dependent claims 5-6 and 23-24, in order to place set of claims 37-42, 60 and 61 within group I. The Examiner replied, in a telephone message on November 4, 2005, that the proposed amendment of a dependent claim of claim 37 that includes a teaching of a telephone network would place claims 37-42 and the newly dependent claims as a set of claims within group I.

Elections/Restrictions

The Examiner restricts the application to one of two claim groupings. Applicants elect group I for examination in compliance with 37 CFR 1.143. In addition, however, regardless of whether the Examiner's assertions as to the groupings are correct, Applicants add claims 60 and 61, which are dependent upon claim 37 and clearly place the invention of claims 37-42, 60 and 61 within the same class as the claims already within group I. In view of the telephone message left by the Examiner indicating that the proposed amendment would allow claims 37-42, 60 and 61 to be placed within group I, Applicants are not canceling claims 37-42, 60 and 61 because these claims are now included in the claims elected with group I.

Grounds of Restriction

In paragraph 2, the Examiner specifies group I as containing claims 1-36 which are "drawn to a method and a system for predicting fraudulent identification usage in a telephone network, classified in class 379, subclass 145." [Office Action, p. 2] In contrast, the Examiner specifies group II as containing claims 37-42 which are "drawn to protecting credit card fraud, classified in class 235, subclass 380." [Office Action, p. 2]

Next, in paragraph 2, the Examiner states that "Inventions I and II are related as combination and subcombination." [Office Action, p. 2] The Examiner cites MPEP 806.05(c) which states "Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

10/022,165

12

Atty Docket: AUS920010844US1

patentability, and (2) that the subcombination has utility by itself or in other combinations.” [Office Action, p. 2] The Examiner concludes that “In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I is directly drawn to a method and a system for predicting fraudulent identification usage in a telephone network. The subcombination has separate utility such as protection fraud in either a telephone network, a credit card system, or others.” [Office Action, p. 2]

In addition, the Examiner responds to Applicants’ previous election with traverse of group I including claims 1-42 in a response filed 8/19/2005. The Examiner notes, in response to Applicants previous arguments that “Applicants should consider all claims in the group or groups or in the specific set of claims, not among independent claims alone. In this case sets of claims 1-8 and 19-36 wherein at least claims 1 and 5-6 and claims 19 and 23-24 in the sets of claims of group I recited the same elements as common (predicting fraudulent identification usage in a telephone network) between claims while set of claims 37-42 does not. None of claims 37-42 recited the feature of a telephone network.” [Office Action, p. 4] The Examiner concludes that “Therefore it is clearly to conclude that set of claims 37-42 is a subcombination and drawn to a fraudulent detection product which may be applied to either a credit card system, a telephone network, or the like while the sets of claims 1-18 and 19-36 are combination having the same elements of a fraud detection product with a telephone network.” [Office Action, p. 4]

Regardless of whether the Examiner’s assertions are correct, Applicants add claims 60 and 61, which are dependent upon claim 37, and which include the feature of a telephone network. According to the Examiner’s instruction to “consider all claims in the group or in the specific set of claims, not among independent claims alone”, claims 37-42 and 60-61 now clearly recite the same elements of “predicting fraudulent identification usage in a telephone network” as the sets of claims 1-8 and 19-36. In view of the amendment, Applicants respectfully assert that sets of claims 1-18, 19-36, and 37-42, 60 and 61 are not distinct or independent and therefore are elected together in group I. Applicants respectfully request examination and allowance of claims 1-42, 60, and 61.

10/022,165
Atty Docket: AUS920010844US1

13

Conclusion

In view of the foregoing, Applicant respectfully requests that a corrected election requirement be issued. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,



on 11/4/05

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10/022,165
Atty Docket: AUS920010844US1

14